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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,274	11/25/2003	Peter J. Ford	884A.0025.U1(US)	2959
29683 7590 07/16/2008 HARRINGTON & SMITH, PC 4 RESEARCH DRIVE SHELTON, CT 06484-6212				
EXAMINER ELCENKO, ERIC J				
ART UNIT 2617		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/725,274

Applicant(s)

FORD ET AL.

Examiner

ERIC ELCENKO

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 and 30-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to the rejection(s) of claim(s) 33 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn and a new rejection made.
2. Applicant's arguments in regard to all other claims have been fully considered but they are not persuasive. In regard to Claim 1, applicant argues the combination of Lin and Lielbriedis does not automatically determines a destination address and the combination together also do not teach this feature. In response to applicant's argument that Lielbriedis is using an SMS message, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).
3. It is obvious to one of ordinary skill in the art the teaching of determining an address from a means of communication, an SMS message and a phone call are easily comparable as both being a means of communication over a communication channel, would easily be combined between the two references. Therefore, the combination does teach "to determine automatically a destination address" from the reply of an SMS message not having to specify the return address as it is automatically known from receipt of the incoming message, herein equivalent to in consequence of the telephone

call, equivocal by the relation of communication, and the claimed subject matter does not overcome the art rejection.

4. In regard to Claim 20, the applicant brings up the argument of the telephone call, which is addressed above and the specification of a destination address as addressed above as well. Hansmann teaches the use of parallel channel to transmit data or information. The applicant's argument does not specify why the parallel data channel of Hansmann is not a parallel data channel as per the claimed subject matter and gives no evidence as to why the Hansmann parallel channels do not teach the same as the claimed subject matter. Therefore, the rejection stands and the claimed subject matter does not overcome the art rejection.

5. In regard to Claim 33, the applicant argues the same points as presented above in regard to the other independent claims of 1 or 20. The same response is used against the arguments for Claim 33 and can be read as addressed above as no new arguments were presented for this claim.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al. (U.S. Pub. No. 2005/0096071) in view of Lielbriedis (U.S. Pub. No. 2001/0051528)

In regard to Claim 1, Lin et al. discloses a method of sending data from a first party participating in a telephone call to a second party in the telephone call (*Lin teaches a system and method for communicating data over a voice channel on a wireless device. The method includes establishing an audio connection with a second device providing an interface for a user for sending data to the second device (Abs)*)

Lin does not directly disclose storing an identifier and using the stored identifier to automatically determine a destination address for a data message. (Para 9)

Lielbriedis teaches identifying information is transmitted to a mobile communication station in the originating address data space of a short message. At a later stage when the mobile responds to the message, the received originating address will constitute the destination address and the identifying information will be returned from the mobile station in the destination address data space of the response. Lin teaches the transfer of data between the two stations and it can obviously be seen that the address of the two mobiles is being used in the exchange as destination addresses for the communication. Lielbriedis is used to show specifically that information in data communication is sent automatically in a response to the originating terminal which sent the data.

It would have been obvious to one of ordinary skill in the art to modify Lin to include the teachings of Lielbriedis in order to directly respond to the communicating

terminal using the original communication identification information as a destination address.

In regard to Claims 2-6, it is obvious to one of ordinary skill in the art that a identifier information that would be stored would be of the setup communication between the two terminals, including the telephone number, a CLI or equivalent.

In regard to Claims 7 and 8, Lielbriedis teaches storing the identifying information and being able to later retrieve the information for a response to the messages. (Para 9)

In regard to Claims 9 and 17, Lielbriedis discloses the destination address is any one of: an email address, a telephone number, a Bluetooth device address. (Para9, *it is also evident the connection is made in Lin by use of a telephone number between the devices*)

In regard to Claims 10-11, 18-19, Lin discloses providing, only during the telephone call a user selectable option to transfer data to the other party participating in the telephone call without user specification of a destination address. (*Lin teaches three options, one of which is sending data to the other party by selecting the option of pushing that particular button. The address of the participating party is not specified as the connection is already made and the address is known. (Para 35 – 39)*)

In regard to Claim 12, Lin et al. discloses a method of sending data from a first party participating in a telephone call to a second party in the telephone call (*Lin teaches a system and method for communicating data over a voice channel on a wireless device. The method includes establishing an audio connection with a second device providing an interface for a user for sending data to the second device (Abs)*)

Lin does not directly disclose storing an identifier and using the stored identifier to automatically determine a destination address for a data message. (Para 9)

Lielbriedis teaches identifying information is transmitted to a mobile communication station in the originating address data space of a short message. At a later stage when the mobile responds to the message, the received originating address will constitute the destination address and the identifying information will be returned from the mobile station in the destination address data space of the response. Lin teaches the transfer of data between the two stations and it can obviously be seen that the address of the two mobiles is being used in the exchange as destination addresses for the communication. Lielbriedis is used to show specifically that information in data communication is sent automatically in a response to the originating terminal which sent the data.

In regard to Claims 13 and 14, it is obvious to one of ordinary skill in the art that a identifier information that would be stored would be of the setup communication between the two terminals, including the telephone number received via the radio cellular transceiver, i.e., the call.

In regard to Claim 15, Lielbriedis teaches storing the identifying information and being able to later retrieve the information for a response to the messages. (Para 9)

In regard to Claim 16, it would be obvious to one of ordinary skill in the art that each message stored from Lielbriedis and its associated identifying information would be connected to a different contact address as each is given a response to its respected received message.

3. Claims 20-29 and 30-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al. (U.S. Pub. No. 2005/0096071) in view of Lielbriedis (U.S. Pub. No. 2001/0051528) in further view of Hansmann et al. (U.S. Pub. No. 2001/0016835)

In regard to Claim 20, Lin discloses while the telephone call is on-going, a user selectable option to transfer data to another party participating in the telephone call without user specification of a destination address. *(The user interface of Lin comprises 3 buttons, including a first button for sending (or pushing) data to the second terminal. In step 512, wherein button 410 for sending data was pressed, the wireless device 106 identifies the data for sending to the wireless device 108 and in step 513 the data is sent. (Para 38))*

Lin does not disclose a new channel that runs in parallel with a voice channel used for the telephone call.

Hansmann teaches during a voice channel connection, data being sent over a parallel data or service channel of the communication device. (Para 21)

It would have been obvious to one of ordinary skill in the art to modify Lin to include the teaching of Hansmann in order to provide a faster and more efficient method of transmitting a data message to another device by having a dedicated channel for data transmission without a further need for conversion for use with a voice communication channel.

In regard to Claim 21, 23, 25 and 29, Lin discloses being able to send phonebook entries, a calendar entry, a permission request, a text message, a V-card an application or the like. (Para 38)

In regard to Claim 22 and 30, the user pushes the send button, 410 and the information will be sent to the second terminal. (Para 38)

In regard to Claim 24, 31 and 35, Lielbriedis teaches storing the identifying information and being able to later retrieve the information for a response to the messages. (Para 9)

In regard to Claim 26, Lielbriedis discloses the destination address is any one of: an email address, a telephone number, a Bluetooth device address. (Para9, *it is also evident the connection is made in Lin by use of a telephone number between the devices*)

In regard to Claim 27, Lin discloses providing, only during the telephone call a user selectable option to transfer data to the other party participating in the telephone call without user specification of a destination address. (*Lin teaches three options, one of which is sending data to the other party by selecting the option of pushing that particular button. The address of the participating party is not specified as the connection is already made and the address is known. (Para 35 – 39)*)

In regard to Claim 28, Lin et al. discloses a method of sending data from a first party participating in a telephone call to a second party in the telephone call (*Lin teaches a system and method for communicating data over a voice channel on a*

*wireless device. The method includes establishing an audio connection with a second device providing an interface for a user for sending data to the second device (Abs))*

Lin does not directly disclose storing an identifier and using the stored identifier to automatically determine a destination address for a data message. (Para 9)

Lielbriedis teaches identifying information is transmitted to a mobile communication station in the originating address data space of a short message. At a later stage when the mobile responds to the message, the received originating address will constitute the destination address and the identifying information will be returned from the mobile station in the destination address data space of the response. Lin teaches the transfer of data between the two stations and it can obviously be seen that the address of the two mobiles is being used in the exchange as destination addresses for the communication. Lielbriedis is used to show specifically that information in data communication is sent automatically in a response to the originating terminal which sent the data.

The combination does not disclose a new channel that runs in parallel with a voice channel used for the telephone call.

Hansmann teaches during a voice channel connection, data being sent over a parallel data or service channel of the communication device. (Para 21)

It would have been obvious to one of ordinary skill in the art to modify Lin to include the teaching of Hansmann in order to provide a faster and more efficient method of transmitting a data message to another device by having a dedicated channel for

data transmission without a further need for conversion for use with a voice communication channel.

In regard to Claim 32, it is obvious to one of ordinary skill in the art that a identifier information that would be stored would be of the setup communication between the two terminals, including the telephone number.

In regard to Claims 33 and 34, Lin et al. discloses a method of sending data from a first party participating in a telephone call to a second party in the telephone call (*Lin teaches a system and method for communicating data over a voice channel on a wireless device. The method includes establishing an audio connection with a second device providing an interface for a user for sending data to the second device (Abs)*)

Lin does not directly disclose storing an identifier and using the stored identifier to automatically determine a destination address for a data message. (Para 9)

Lielbriedis teaches identifying information is transmitted to a mobile communication station in the originating address data space of a short message. At a later stage when the mobile responds to the message, the received originating address will constitute the destination address and the identifying information will be returned from the mobile station in the destination address data space of the response. Lin teaches the transfer of data between the two stations and it can obviously be seen that the address of the two mobiles is being used in the exchange as destination addresses for the communication. Lielbriedis is used to show specifically that information in data

Art Unit: 2617

communication is sent automatically in a response to the originating terminal which sent the data.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC ELCENKO whose telephone number is (571)272-8066. The examiner can normally be reached on M-F 7:30 AM through 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on (571) 272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VINCENT P. HARPER/  
Supervisory Patent Examiner, Art Unit 2617

ee

